

REMARKS

The Non-final Office Action mailed May 11, 2009 (hereinafter, "Office Action") has been reviewed and the Examiner's comments considered. Claims 23, 24, 33, 34, 37, 38, and 41-43 are pending in this application. No amendments are presented herein.

Claim Rejections - 35 U.S.C. § 103

Claims 23, 24, 37, 38, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 4,198,960 to Utsugi (hereinafter "Utsugi") in view of USPN 6,371,963 to Nishtala (hereinafter "Nishtala"). Claims 33 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Utsugi in view of Nishtala in further view of U.S. Pub. 2002/0019594 to McClellan et al. (hereinafter "McClellan"). Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Utsugi in view of Nishtala in further view of USPN 6,527,781 to Bates (hereinafter "Bates"). Applicants respectfully traverse these rejections.

Independent claim 23 recites, *inter alia*, "a first actuator configured to extend the first operating member so as to extend the first and second legs and to simultaneously retract the second operating member so as to retract the third leg, such that the tip member is displaced rearward and the first and second legs are displaced away from each other to facilitate maneuvering the basket around an object."

The Office Action alleges that Utsugi teaches "a first actuator ... configured to extend the first operating member so as to extend the first and second legs and to simultaneously retract the second operating member so as to retract the third leg ... such that the tip member is displaced rearward and the first and second legs are displaced away from each other to facilitate maneuvering the basket around an object" as recited in claim 23. (Office Action, p. 2). Applicants respectfully disagree.

Utsugi teaches that the certain "trapping wires 33 ... are extended farther than the rest of the trapping wires 33 to cause them to be outwardly curved." Extending one set of wires farther than another set of wires does not teach or suggest "simultaneously" extending a set of wires while

retracting another set of wires. In Utsugi “the trapping wires 33 facing the stone 44 are withdrawn” *after* the extension. (Utsugi, col. 4:43-44). The motions do not occur “simultaneously.”

Further, as the Office Action admits, “the trapping wires 33 are individually operated.” (See, Office Action, p.2, quoting Utsugi, col. 4:36-37, emphasis added.) Accordingly, because the trapping wires are “individually operated” Utsugi does not teach or suggest *a single actuator* (“a first actuator”) that extends “the first and second legs and to simultaneously retract[s] the third leg, such that the tip member is displaced rearward and the first and second legs are displaced away from each other to facilitate maneuvering the basket around an object” as recited in claim 23.

As the Office Action admits, Utsugi does not teach or suggest “operating members.” (Office Action, p. 3).¹ The Office Action relies on Nishtala to make up for the deficiencies of Utsugi. The Office Action alleges that needle base 115 and wirebase 113 are the “operating members.” However, even assuming *arguendo* that this allegation is correct, nothing in either Utsugi or Nishtala teach or suggest “a first actuator configured to extend the first operating member so as to extend the first and second legs and to simultaneously retract the second operating member so as to retract the third leg, such that the tip member is displaced rearward and the first and second legs are displaced away from each other to facilitate maneuvering the basket around an object,” as recited in claim 23.

As taught in Nishtala, the needle base 115 moves the needle 111 and the wirebase 113 moves the wire 109. The needle 111 and the wire 109 are two separate elements rather than different legs of a basket. Accordingly, the combination of Utsugi and Nishtala fails to teach or suggest a retrieval device with a single actuator that controls multiple trapping wires.

¹ Applicants note that this admission appears to conflict with the allegations related to the teachings of Utsugi on page 2 of the Office Action. Based on the clear statement that Utsugi “does not specify operating member,” Applicants believe including “operating member[s]” in the discussion of the teachings of Utsugi on page 2 to be a typographical error and thus address the combination presented.

Further, regarding the propriety of combining references, the MPEP clearly states that it “is improper to combine references where the references teach away from their combination” (MPEP § 2145, p. 2100-168, Eighth Edition, Rev. 6, Sept. 2007), and cautions against modifying references when the proposed modification would render the modified reference unsatisfactory for its intended purpose (MPEP § 2143.01, p. 2100-140, Eighth Edition, Rev. 6, Sept. 2007). “If the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, p. 2100-141, Eighth Edition, Rev. 6, Sept. 2007).

Utsugi clearly describes the trapping wires as being individually operated. (Col. 4:36-37, emphasis added.) Accordingly, it is improper to combine Utsugi with Nishtala because the proposed combination would change the principle of operation of the Utsugi device and render it unsatisfactory for its intended purpose. In particular, because the Utsugi device is intended to allow for individually operated trapping wires,² a modification of the device with the mechanism of Nishtala according to the proposal in the Office Action would necessarily prevent this intended operation from occurring.

Accordingly, Applicants submit that a *prima facie* case of obviousness is not established in view of the above and that, therefore, independent claim 23 is patentable over the asserted combination of Utsugi/Nishtala. With respect to dependent claims 24, 37, and 38, without conceding the allegations in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that each depends from patentable independent claim 23 and is therefore patentable.

² “By individually operating the trapping wires a foreign matter within the body cavity can be positively caught.” (Utsugi, Abstract.)

Independent claim 41 includes similar limitations to independent claim 23 and is patentable for at least the reasons discussed above. Specifically, claim 41 recites “rotation of the *rotatable actuator* in a first direction moves the first and second gear racks so as to *extend* the first operating member and *the first and second legs* and to *simultaneously retract* the second operating member and *the third leg*, and wherein rotation of the rotatable actuator in a second direction opposite the first direction moves the first and second gear racks so as to *extend* the second operating member and *the third leg* and to *simultaneously retract* the first operating member and *the first and second legs*.” (Emphasis added.) With respect to dependent claim 42, without conceding the allegations in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that claim 42 depends from patentable independent claim 41 and is therefore patentable.

Accordingly, Applicants request favorable reconsideration and withdrawal of the rejections of claims 23, 24, 37, 38, 41, and 42 under 35 U.S.C. § 103.

With respect to dependent claims 33, 34, and 43, without conceding the propriety of the asserted combinations, or the assertions made in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that each of the rejected dependent claims 33 and 43 (Utsugi/Nishtala/McClellan) and 34 (Utsugi/Nishtala/Bates) depend from a patentable independent claim, in view of the above, and are therefore patentable.

Accordingly, Applicants request favorable reconsideration and withdrawal of the rejections of claims 33, 34, and 43 under 35 U.S.C. § 103.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicants of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

In the event that the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **50-2191**, under Order No. 101674.0027P2. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 11, 2009

Respectfully submitted,

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